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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2709/113

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on 9/25/06Signature [Signature]Typed or printed name Jeffrey T. Klayman

Application Number

09/882,292

Filed

June 15, 2001

First Named Inventor

Laura T. Putnam

Art Unit

3623

Examiner

Boyce, A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 39,250

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

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DateNOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.☒ *Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

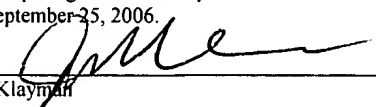
Applicant: Putnam et al.
Appl. No: 09/882,292
File Date: June 15, 2001

Art Unit: 3623
Examiner: Boyce, A.
Docket No.: 2709/113

Invention: **System and Method of Identifying Options for Employment Transfers
Across Different Industries**

CERTIFICATE OF MAILING

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Jeffrey T. Klayman

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P.O. Box 1450
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Following a Final Office Action dated July 11, 2006, Applicants submit the present Request for Formal Review, by a panel of examiners, of the legal and factual basis of the rejections pending in the present case, in accordance with the Pre-Appeal Brief Conference Pilot Program¹. Applicants believe that the issues presented are well-posed for appeal, and request formal review prior to appeal on the following grounds:

I. Background Synopsis of Subject Matter

The present application relates to systems and methods for analyzing job functions across different industries, particularly for identifying employment options for individuals and for identifying appropriately qualified job candidate populations for employers. The method utilizes a computer to identify a job function in a first industry. The system and method then access a database and correlates the job function in the first industry with a set of second industries in which the job function may be transferable.

II. Synopsis of Status of the Case

Claims 3-62, 80-102, and 104-124 are pending in the application. In the Final Office Action of July 11, 2006, Claims 3-6, 8-12, 14, 15, 17, 19, 21, 23, 24, 28-30, 34-38, 40, 42, 43, 45, 47, 49, 51, 53-55, 59, 61, 80-102, 104, 105, 111, 112, 118, and 119 were rejected under 35 U.S.C. 102(b) as being anticipated by Salmon et al., U.S. Patent No. 5,592,375. Additionally, claims 7, 13, 16, 18, 20, 22, 25-27, 31-33, 39, 41, 44, 46, 48, 50, 52, 56-68, 60, and 62 were rejected under 35 U.S.C. 103(a) as being unpatentable over Salmon in view of Joao, U.S. Patent No. 6,662,194. Lastly, claims 106-110, 113-117, and 120-124 were rejected under 35 U.S.C. 103(a) as being unpatentable over Salmon et al.

A telephonic interview was held on March 29, 2006 between Examiner Andre Boyce and Applicants' Attorneys Bruce Sunstein and Jeffrey Klayman to discuss the Office Action of February 2, 2006. Specifically, the Salmon reference was discussed in relation to the claimed invention. Salmon describes a computer-implemented system for brokering transactions between sellers and buyers of goods or services. The Salmon reference correlates the information in each line item of a resume without regard to potential transferability of job function capability.

A response was filed on April 21, 2006 in which the Applicants explained that the claims of the subject patent application require the use of a database that correlates a job function in a first industry with a set of second industries with respect to which the job function capability is potentially transferable in order to identify the set of second industries. Applicants further explained that the Salmon reference does not teach or suggest the type of correlations carried out by the present invention. Salmon does not deal with evaluating potential transferability of job functions among industries. In fact, Salmon structures his system to avoid the types of correlations employed in the subject application. (Col. 4, lines 50-57).

Applicants received a Final Office Action dated July 11, 2006 in which the Examiner essentially maintained his former position that the claims are anticipated by Salmon et al alone or in combination with Joao.

¹ Official Gazette of the United States Patent and Trademark Office, vol. 1296, Number 2, (July 12, 2005).

The appeal, noticed concurrently herewith, is with respect to rejected claims 3-62, 80-102, and 104-124.

III. Issues for Review Prior to Appeal

1. The rejection of claims 3-62, 80-102, and 104-124 is improper and must be withdrawn because Salmon et al. fails to teach or otherwise suggest, alone or in combination with Joao, the use of a database to correlate a job function in a first industry with a set of second industries as required by the claims.

It is well settled that a claim is invalid as anticipated under 35 U.S.C. § 102 only if a single prior art reference discloses either expressly or inherently, each limitation of the claim. *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 64 U.S.P.Q. 2d 1202 (Fed. Cir. 2002). Additionally, as set forth in MPEP §§ 2143 and 2143.03, the cited prior art references must teach or suggest all claim limitations before a *prima facie* case of obviousness can be made. Salmon et al. simply do not disclose each and every limitation of the present claims, alone or in combination with Joao.

The claims require the use of a database that correlates a job function in a first industry with a set of second industries with respect to which the job function capability is potentially transferable in order to identify the set of second industries. The present application provides examples of such correlations. For example, FIG. 1-1 of the subject patent application shows correlations between a marketing management function in each of a number of first industries to a corresponding set of second industries. The letter "X" at the intersection of a row and a column indicates potential transferability between the job function capability in the first industry and the second industry. Applicants note that correlations are not necessarily bilateral. For example, it can be seen that the marketing management function in the consumer package goods industry (row 1) is potentially transferable to the consumer durables industry (as indicated by the letter "X" at the intersection of row 1 and column 2), but the marketing management function in the consumer durables industry (row 2) is not transferable to the consumer package goods industry (as indicated by an empty box at the intersection of row 2 and column 1). In the

context of the subject patent application, the correlation is based on an evaluation of the skill set associated with the job function.

The Salmon reference does not teach or otherwise suggest the type of correlations employed in the subject patent application. In fact, Salmon explicitly teaches that correlations of the type discussed above do not count and structures his system to avoid considering such correlations. Pointedly, at column 4, lines 50-57, Salmon says that a person with “production experience” in the biotechnology industry and “design experience” in the aerospace industry does not match a search for someone with “design experience in biotechnology” (i.e., even though the person has both “design experience” and experience in biotechnology). Salmon makes no attempt to correlate, say, design experience in aerospace with other industries to which that job function capability is potentially transferable, say, for example, the biotechnology industry. The apparent goal of Salmon is to ensure that a particular subject is not considered for a particular job unless the subject already has experience with that job in the relevant industry.

Further, the Salmon reference requests that the user input a number of criteria, including the industries in which the user desires to search. If a user fails to input the desired industry, the Salmon system will search based on the other criteria, without regard to the industry (Col. 5, lines 38-46). For example, as stated in column 5, lines 38-46 of Salmon, if a buyer using the Salmon database searches for “design experience in the Aerospace industry”, the system will return only those candidates with that specific experience. The system will not return candidates with experience in potentially transferable industries. Alternatively, if a user of the Salmon system only searches for “design experience”, the system will return candidates with design experience regardless of the industry and regardless of whether the experience in that industry is transferable. Therefore, the Salmon system does not correlate a job function in a first industry with a set of second industries with respect to which the job function capability is potentially transferable, as required by the claims. Rather, the Salmon database merely searches based on the inputted criteria. It is clear, then, that Salmon does not deal at all with evaluating potential transferability of job functions among industries, and actually disparages the types of correlations employed in the subject patent application.

Prior to the subject application, there was no known framework to perform the claimed invention, either manually or via computer. Where job recruiting has typically been a subjective activity (e.g., a marketing manager assumes that he can market anything to anyone at any time and therefore can move to any industry; job recruiters send job applicants on interviews hoping for a hire), the subject patent application provides an objective way to evaluate the potential transferability of a job function from one industry to another. Some examples of how such correlations might be used by a job applicant, a potential employer, and a job recruiter include: (1) a job recruiter using the computerized method of the subject patent application to identify other industries in which a job applicant's skills are transferable, and (2) a potential employer using the computerized method of the subject patent application to determine whether the skill set of a job applicant is transferable to its industry based on the previous job function(s) performed by the job applicant).

Applicants therefore submit that claims 3-62, 80-102, and 104-124 are patentable over Salmon alone and in combination with Joao. Allowance of claims 3-62, 80-102, and 104-124 is respectfully requested.

Respectfully submitted,



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